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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re SmithKline Beecham Corporation

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Serial No. 75/134,262

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Gary Krugman of Sughrue, Mion, Zinn, MacPeak & Seas, PLLC
for SmithKline Beecham Corporation

Adam Striegel, Trademark Examining Attorney, Law Office 105
(Thomas Howell, Managing Attorney)

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Before Seeherman, Hairston and Chapman, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

SmithKline Beecham Corporation has filed an application to register the mark TIMEPILLS for "pharmaceutical preparations for the alleviation of the symptoms of the common cold and allergies".[1]

[1] Appl. Ser. No. 75/134,262, filed July 15, 1996, alleging a bona fide intention to use the mark. The application, as originally filed, included a claim of ownership of Reg. No. 1,684,264 for

Registration has been refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the basis that, when used on applicant's goods, the mark is merely descriptive of them. The Examining Attorney also refused registration because applicant's claim of distinctiveness is inappropriate in an intent-to-use application, and the claim of distinctiveness, based solely on applicant's claim of ownership of Registration No. 1,684,264, is insufficient. Finally, the Examining Attorney twice required additional information about applicant's goods pursuant to Trademark Rule 2.61(b), to which applicant never responded.

Applicant has appealed.[2] Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested.

The issues before the Board are (1) whether applicant's mark TIMEPILLS is merely descriptive when applied to its goods; (2) if the mark is merely descriptive, whether applicant's mark has acquired distinctiveness under Section 2(f) based solely on applicant's prior registration; and (3) whether the

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the mark TINY TIME PILLS; as well as a claim of distinctiveness under Section 2(f) based on the prior registration.

[2] This appeal is not from a final Office Action, but rather arose from the second refusal on the requirements and refusals listed above. See Trademark Rule 2.141.

Examining Attorney's requirement for additional information regarding the goods is proper.

Turning first to the question of descriptiveness under Section 2(e)(1) of the Trademark Act, it is the Examining Attorney's position that the mark merely describes the main feature and characteristic of the goods (time) and the form of the goods (pills); and that the mark is no more than a combination of two merely descriptive terms, with the composite mark remaining merely descriptive. Specifically, the Examining Attorney asserts that the term TIMEPILLS merely describes pharmaceutical tablets which release medicine over time into a person's body.

In support of this refusal the Examining Attorney submitted definitions from Webster's II New Riverside University Dictionary of the word "time" as "designed so as to operate at a particular moment", and of the word "pill" as "a small, often coated tablet or pellet of medicine, taken by swallowing whole or chewing"; and excerpts from 62 of 180 articles[3] retrieved from a LEXIS/NEXIS database search of the phrase "time pill(s)".

[3] We must comment that the Board finds such a wholesale submission of 62 excerpts to be burdensome to the applicant and the Board. While we have in the past criticized Examining Attorneys for submitting an insufficient number of excerpted articles, this has been in situations where only one or two excerpts have been submitted, although the search shows a very large number of articles were retrieved. However, we have never

Applicant contends, in urging reversal of the refusal, that the mark is at most suggestive because it requires "mature thought or analysis" (brief, p. 6) to understand the characteristic or feature of the goods; and that the Examining Attorney has not met his burden of making a prima facie showing of descriptiveness. Specifically, applicant argues that the dictionary definitions do not lead to the conclusion that the term TIMEPILLS is merely descriptive; and that the LEXIS/NEXIS evidence is a jumble of evidence most of which is not proof of the descriptiveness of the term TIMEPILLS.

In analyzing the LEXIS/NEXIS evidence it is clear that most of the 62 excerpted articles refer to the words "tiny time pills", and not "time pills" or "timepills". Also, a few of the excerpted stories are from foreign newspapers or news services and are thus irrelevant here [see In re Hines, 31 USPQ2d 1685, footnote 4 (TTAB 1994)]; some of the stories may be a misuse of applicant's trademark TINY TIME PILLS; and some of the LEXIS/NEXIS stories refer to matters completely unrelated to pharmaceutical products (for example, there are book reviews, a story about a

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suggested that Examining Attorneys must submit dozens and dozens or all such articles retrieved in a search. Rather, the Board has consistently stated that a representative selection of the relevant articles are sufficient, as long as the Examining Attorney indicates that the articles are representative.

photography exhibit, and a story about synthetic soil.)

Many of the stories in fact refer to applicant and applicant's previously registered trademark TINY TIME PILLS, as shown by the examples below:

> "...Contac's tiny time pills sell just as heavily in Japan as they do in the United States. Jeremy Heysfeld, spokesman for the manufacturer, Philadelphia-based..." (January 9, 1992 article from The San Diego Union-Tribune)

> "...commercial for SmithKline Beecham's Contac. The veteran sitcom actors work in Contac's pitch about '600 tiny time pills'. They also introduce a selling point: 'There's a whole day's work in every Contac'. But the ad is mostly Conway and..." (November 26, 1990 article from ADWEEK)

> "For years, the SmithKline Beecham Corporation aired a successful television commercial that showed 'hundreds of tiny time pills' spilling from an opened Contac capsule.
> No drug company would air that type of commercial now. Today, the thought of capsules..." (August 17, 1986 article from The New York Times).

There are, however, stories relating to the death of the scientist who apparently developed slow-release time pills. Specifically, an excerpt from The New York Times dated March 27, 1987 states the following:

> "...chemistry and pharmacuetics, dies [sic] underwent cardiovascular bypass surgery March 18.
> Among his scientific accomplishments was the development of slow-release time pills, such as those used in nonprescription cold medicines and certain prescription drugs, including an antiglaucoma compound and a contraceptive used..."

Section 2(e)(1) of the Trademark Act precludes registration of a mark on the Principal Register if it "consists of a mark which, when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them". It is well settled that a term is considered merely descriptive of goods or services, within the meaning of Section 2(e)(1), if it immediately describes an ingredient, quality, characteristic or feature thereof, or if it directly conveys information regarding the nature, function, purpose or use of the goods or services. See In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978). It is not necessary that the term describe all of the properties or functions of the goods or services in order for the term to be considered merely descriptive thereof; rather it is sufficient if the term describes a significant attribute or idea about them. And, of course, whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought and the possible significance that the term may have to the average purchaser of the goods or services because of the manner of its use. See In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979). See also, In re Consolidated Cigar Co., 35 USPQ2d 1290 (TTAB

1995); and In re Pennzoil Products Co., 20 USPQ2d 1753 (TTAB 1991).

As stated in the case of In re Gould Paper Corporation, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987), the Patent and Trademark Office may satisfy its evidentiary burden by means of dictionary definitions showing that the "separate words joined to form a compound have a meaning identical to the meaning common usage would ascribe to those words as a compound". In the case now before the Board, the Examining Attorney has provided dictionary definitions of the terms 'time' and 'pill'. These two ordinary words have a commonly understood meaning, and when used in connection with pharmaceutical preparations for alleviation of the symptoms of the common cold and allergies, the public would understand the words to mean a pill which releases medicine into the body over some amount of time. That is, the public would understand that applicant's product is a time-release pill. Moreover, we note that applicant's prior registration for the mark TINY TIME PILLS registered under Section 2(f) of the Trademark Act, and included a disclaimer of the term PILLS. Thus, at the time that registration issued applicant had conceded that its mark TINY TIME PILLS was descriptive, and that the term PILLS was generic. We find that when considered in

relation to its use on applicant's goods, the term TIMEPILLS would be readily perceived by purchasers as identifying pills which release medicine over time into the body.

Applicant asserts that the Examining Attorney's refusal to register TIMEPILLS as merely descriptive is an impermissible collateral attack on applicant's prior incontestable registration for the mark TINY TIME PILLS for pharmaceutical preparations for the alleviation of the symptoms of the common cold, flu and allergies, citing the case of In re American Sail Training Association, 230 USPQ 879 (TTAB 1986). In the cited case, that applicant applied to register the mark RETURN OF THE TALL SHIPS, and the Examining Attorney required a disclaimer of the words TALL SHIPS apart from the mark despite the fact that the applicant owned a prior incontestable registration for the mark TALL SHIPS for the identical services.

We find the American Sail case, supra, is not applicable in the case now before the Board because applicant's prior registration for TINY TIME PILLS issued under Section 2(f) and included a disclaimer of the generic term 'pills'. While the public may recognize applicant's registered mark TINY TIME PILLS as identifying applicant, there is no indication in this record as to how the public

will understand the term TIMEPILLS based solely on their knowledge of the mark TINY TIME PILLS. Moreover, each application for registration of a mark must be separately evaluated. See In re Loew's Theaters, Inc., 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985); In re Stanbel Inc., 16 USPQ2d 1469 (TTAB 1990); and In re Bank America Corp., 231 USPQ 873 (TTAB 1986). The Examining Attorney's refusal to register applicant's mark TIMEPILLS under Section 2(e)(1) is not a collateral attack on applicant's prior registration of the mark TINY TIME PILLS.

In view of the foregoing, we find that TIMEPILLS is merely descriptive as applied to applicant's goods.

Turning next to the alternative issue of acquired distinctiveness, we will first address the question of whether applicant may "clarify" its Section 2(f) claim. The original application included a claim of ownership of Registration No. 1,684,264, and the following statement: "The word 'TIMEPILLS' has become distinctive under Section 2(f) of the Trademark Act based on prior U.S. Registration No. 1,684,264 for TINY TIME PILLS." The Examining Attorney has pointed to this statement as a concession by applicant that its mark is not inherently distinctive. Applicant, however, asserts that by its April 30, 1997 response to the first Office action applicant made it "clear and

unequivocal" (brief, p. 3) that the Section 2(f) claim was made in the alternative only. We agree with the Examining Attorney that there was nothing in the original application to indicate the Section 2(f) claim was an alternative position. However, to prevent applicant from "clarifying" its alternative position is simply too technical.[4] Treating applicant's claim under Section 2(f) as an alternative claim, such a position by applicant is not deemed as applicant's concession or admission of the descriptiveness of the mark.[5]

Turning now to the merits of applicant's alternative position that its mark TIMEPILLS has acquired distinctiveness on the basis of a prior registration for the mark TINY TIME PILLS, applicant has the burden of establishing that its mark has become distinctive. See

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[4] We would point out that the Board allows withdrawals of disclaimers which were offered only in anticipation of avoiding a problem.

[5] A second matter regarding the claim of distinctiveness involves the applicability of TMEP §1212 to this case. In the first Office action, the Examining Attorney stated (1) that since applicant has filed an intent-to-use application and applicant has not alleged use of the mark in commerce in either an amendment to allege use or a statement of use, "the claim of distinctiveness under Section 2(f) is inappropriate and must be deleted", citing TMEP §1212.09(a); and (2) that applicant's claim of acquired distinctiveness is based on a prior registration which is not for the "same" mark for purposes of acquired distinctiveness, and the claim of acquired distinctiveness is "both premature and insufficient", citing TMEP §1212.04(b).

The Examining Attorney's first statement is incorrect. Clearly, TMEP Section 1212.09(a) and (b) provides for the filing of a claim of distinctiveness in an intent-to-use application.

Bausch & Lomb Inc. v. Leupold & Stevens Inc., 6 USPQ2d 1475 (TTAB 1988).

Applicant's prior registration is for a different mark, TINY TIME PILLS. Even though the prior registration includes the current mark within it, the applied-for mark, TIMEPILLS, does not include the word TINY, and depicts TIMEPILLS as one word. The public's association of the mark TINY TIME PILLS with applicant does not mean that the mark TIMEPILLS will automatically be seen by the public as also indicating source in applicant; and applicant has provided no evidence at all as to the public perception of the applied-for mark. Applicant's claim under Section 2(f) falls far short of a showing that the mark TIMEPILLS has acquired distinctiveness.

Finally, we turn to the third issue before us, whether the Examining Attorney's requirement for additional information was proper.

In the first Office action the Examining Attorney's requirement for information referred to the "nature of the goods" and the "proper identification and classification of the goods". The Examining Attorney also went on to explain and require that if materials on applicant's goods were not available, then "applicant must submit a photograph of similar goods and must describe the nature, purpose and

channels of trade of the goods on which the applicant has asserted a bona fide intent to use the mark." In response to the first Office action, applicant offered an amendment to the identification of goods but made no comment or argument as to the requirement for information.

The Examining Attorney continued the requirement in the second Office action, noting that applicant had failed to respond to the requirement. He did not include a reference to the identification and classification of the goods; but the Examining Attorney used the same language regarding a requirement for a photograph and a description of the nature, purpose and channels of trade of applicant's goods. In response to the second Office action, applicant offered a second proposed amendment to the identification of goods (which was accepted by the Examining Attorney), and again made no response whatsoever as to the requirement for additional information.

Applicant has, for the first time in its brief, argued the merits of the impropriety of the requirement.

It is applicant's position that the Examining Attorney's requirement for additional information referred only to the identification and classification of the goods. This argument is disingenuous. If applicant felt the requirement was not valid, applicant should have so stated

and supported its position in response to the requirement. Instead, applicant chose to ignore the request until filing its brief on appeal. See In re Babies Beat Inc., 13 USPQ2d 1729 (TTAB 1990).

Trademark Rule 2.61(b) provides that the Examining Attorney "may require the applicant to furnish such information and exhibits as may be reasonably necessary to the proper examination of the application". TMEP §1105.02 provides, in part, that the Examining Attorney's request must be "reasonable and pertinent"; and that the Examining Attorney "should state why the information is needed, if the reason is not obvious".

We find that the requirement was proper both in the first Office action, and in the second (repeated) Office action. In both the original and second requests for additional information, there were reasons set forth by the Examining Attorney. And, even if the Examining Attorney had cited no specific reason for the requested information, it was "obvious" in this case that the requirement related to the refusal to register the mark as merely descriptive. The Examining Attorney's requirement for information under Trademark Rule 2.61(b) was not arbitrary or otherwise without basis.

Decision: The refusal to register and the requirement for additional information is affirmed.

E. J. Seeherman

P. T. Hairston

B. A. Chapman
Administrative Trademark Judges,
Trademark Trial and Appeal Board